

Moreover, the Examiner neither clearly designated all the teachings in Bauer being relied upon nor clearly explained the pertinence of Bauer. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).¹

In the statement of the rejection, the Examiner's entire analysis rested on asserting that feature 14 in Bauer corresponds to the claimed driver section and feature 16 in Bauer corresponds to the claimed extension section. Although the Examiner asserted that Bauer discloses a vent, the Examiner failed to establish what feature in Bauer discloses the claimed vent. Based upon the Examiner's analysis, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of anticipation.

Claim 7, as presented in the Amendment dated August 22, 2003, recites more than just a driver section, an extension section, and a vent. The Examiner's statement of the rejection, however, only addresses these features. For example, claim 7 recites that the vent is an active vent, and not only has the Examiner failed to construe a meaning for the term "active vent" consistent with the specification, the Examiner failed to explain how Bauer identically discloses the claimed active vent. Claim 7 also recites that the extension section has two opposite ends, one being attached to the driver section and one end being open, but these limitations were not addressed in the Examiner's rejection. Claim 7 also recites that the device is a shock tube, and

¹ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

thus, the terms "driver section" and "extension section" would be interpreted by one having ordinary skill in that light. However, the Examiner has put forth, as identically disclosing the claimed invention, a driving tool for fasteners that bears no resemblance to the claimed shock tube. Therefore, Applicants respectfully submit that the Examiner has not presented a prima facie case of anticipation since the Examiner has failed to establish that Bauer identically discloses each of the claimed limitations recited in claim 7.

Notwithstanding, Applicants have also amended claim 7 to clarify the limitations recited therein. For example, claim 7 now recites that the driver section defines a chamber, and this limitation is neither taught nor suggested by Bauer since the driver member 14 of Bauer appears to be a solid blade (column 3, lines 23-29). Furthermore, new claim 22 also recites that in one mode, a fluid connection exists between a cavity in the extension section and the chamber in the driver section, in another mode, the cavity in the extension section is fluidly separated from the chamber in the extension section. Since Bauer fails to teach that the driver member 14 includes a chamber, Bauer cannot teach that a fluid connection exists between a chamber in the driver member 14 and a cavity in the extension section 16. Applicants, therefore, respectfully solicit the withdrawal of the imposed rejection of claim 7 under 35 U.S.C. § 102 for anticipation based upon Bauer.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

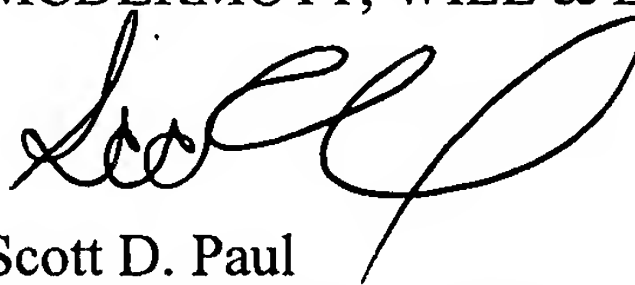
Application No.: 10/046,911

remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read 'Scott D. Paul', written over a horizontal line.

Scott D. Paul
Registration No. 42,984

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SDP/DAS:kap
Date: November 5, 2003
Facsimile: (202) 756-8087

REMARKS

At the time of the Office Action dated October 3, 2003, claims 1-20 were pending in this application. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 1-6 and 8-20. Claim 7 has been amended and new claim 22 has been added. Claim 7 has been amended to recite that a driver section defines a chamber. New claim 22 recites that in one mode, a fluid connection exists between a cavity in the extension section and a chamber in the driver section, in another mode, the cavity in the extension section is fluidly separated from the chamber in the extension section, and this limitation finds support throughout the originally-filed disclosure, for example, on pages 7 and 8. Applicants submit that the present Amendment does not generate any new matter issue.

Claim 7 is rejected under 35 U.S.C. § 102(b) for anticipation based upon Bauer et al., U.S. Patent No. 5,511,714 (hereinafter Bauer)

In the second enumerated paragraph of the Office Action, the Examiner asserted that Bauer discloses a shock tube corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference. As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference. That burden has not been discharged.